Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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AND INTERFERENCES
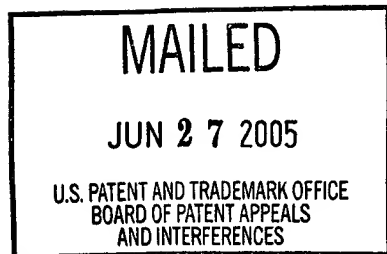
<u>Ex parte</u> RAVI GANESAN

Appeal No. 2005-0685
Application No. 09/298,889

ON BRIEF[1]

Before THOMAS, BLANKENSHIP, and NAPPI, <u>Administrative Patent Judges</u>.

BLANKENSHIP, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 7, 8, 12-14, 17, 22, 23, 26, 27, and 29-32, which are all the claims remaining in the application.

We reverse.

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[1] In view of our decision to reverse the standing rejections, the oral hearing scheduled for June 8, 2005 was rendered moot and vacated.

BACKGROUND

The invention relates to a system for electronic bill presentment and payment

that includes a central clearinghouse, suitable for use with public networks such as the

Internet.   Claim 7 is reproduced below.

7.   A system for electronically paying bills using a network having a plurality
of user stations, each representing a different one of a plurality of users
including payers and payees, the plurality of different users having associated
payment accounts and deposit accounts maintained at a plurality of financial
institutes, comprising:

    a processor configured to receive an instruction, from a first of the
plurality of user stations representing a first of the payers, to make payment of a
first bill to a first of the payees, to transmit a directive to transfer funds to a first
of the deposit accounts associated with the first payee in accordance with the
received instruction to pay the first bill, and to generate remittance information
associated with payment of the first bill; and

    a central database configured to store the remittance information so as to
be accessible to a second of the plurality of user stations representing the first
payee;

    wherein the processor is further configured to receive a request to access
the remittance information from the second user station, to retrieve the
remittance information from the central database based upon the received
access request, and to transmit the retrieved remittance information to the
second user station.

The examiner relies on the following reference:

Chang et al. (Chang)   5,884,288   Mar. 16, 1999
                                                                (filed Dec. 9, 1996)

Claims 7, 8, 12-14, 17, 22, 23, 26, 27, and 29-32 stand rejected under 35 U.S.C.

§ 102 as being anticipated by Chang.

Claims 7, 8, 12-14, 17, 22, 23, 26, 27, and 29-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chang.

An earlier rejection of claims 7, 8, 12-14, 17, 22, 23, 26, and 27 under 35 U.S.C. § 112, second paragraph has been expressly withdrawn by the examiner.

We refer to the Final Rejection (Paper No. 23) and the Examiner's Answer (Paper No. 27) for a statement of the examiner's position and to the Brief (Paper No. 26) and the Reply Brief (Paper No. 30) for appellant's position with respect to the claims which stand rejected.

OPINION

All the claims before us stand rejected under 35 U.S.C. § 102 as being anticipated by Chang. Chang describes an electronic bill payment system having a community of payors, payees, payor banks, and payee banks that are interconnected by a computer network. As shown in Figure 5 of the reference, a payor sends bill payment instructions to the payor's bank (having a bill payment database), which sends electronic checks to the payee, with the payee subsequently endorsing the checks for deposit in the payee's bank. Appellant's disclosed system, which includes a central clearinghouse (Fig. 1), is different in architecture from the distributed system described by Chang. The key question in the instant anticipation inquiry is whether the invention

as claimed by appellant brings out distinguishing features that cannot be met by the Chang system.

Instant claim 7 requires, at a minimum, a processor configured to receive an instruction from a payer to make payment of a bill to a payee and, inter alia, generate remittance information associated with payment of the bill. The claim further requires a central database configured to store the remittance information so as to be accessible to the payee, wherein "the processor" -- i.e., the same processor that receives the instruction for payment -- is further configured to retrieve and transmit the remittance information from the central database upon the payee's request.

The statement of the rejection (Final Rejection at 3-4) does not specify where this "remittance information" is disclosed in Chang. According to the Answer (at 5) the remittance information "is generated and contained within the electronic check . . . which is later stored in an electronic envelope at the payee's designated routing destination for the payee to later access and process both the check and the remittance information." The examiner adds (Answer at 5, 6, and 8) that the "payee's designated computing routing destination," purportedly described at column 10, lines 1 through 6 of the reference, corresponds to the claimed "central database."

Chang at column 10, lines 1 through 6 refers to bill processor 234 (Fig. 6) using a routing table 240 to determine the destination of the computing system associated with a payee 208, to which is forwarded an electronic check envelope. The description

of routing an electronic check envelope to a payee is in the context of payment of bills from payors to payees. Chang's description includes the case in which payors and payees may have accounts in the same bank (col. 5, ll. 10-21).

While a payee's "designated computing routing destination" would be presumed to be accessible by the payee, we find no disclosure in Chang of a processor that generates, and stores in a central database, remittance information that may be accessed from that database by the payee, via a request to the processor. The payee's associated computing system described at column 10, lines 1 through 6, to which an electronic check envelope is forwarded, is that of the payee (Fig. 4; col. 6, ll. 28-54), networked with the payor's and payee's banks, or networked with the common bank if shared by a particular payor and a particular payee. In the interactions depicted in Figure 5 (col. 6, l. 55 et seq.), even if the payor and payee have payment and deposit accounts, respectively, in the same bank, an electronic check envelope is transferred to the payee for endorsement before deposit of the checks in the payee's account in the bank. In Chang's system, the processor that receives payment instructions from a payor has no control over where or how the payee may store and access information in its own computer system.

Chang does describe a bill payment database (element 250; Figs. 5 and 6) that may receive billing information from payees (col. 4, ll. 37-43) and may contain a list of recently paid bills (col. 6, ll. 56-61). Any remittance information associated with the

paid bills would be accessible by the payor (col. 4, II. 44-46). The reference does not,

however, disclose or suggest that a payee may access the information in the bill

payment database, as the information is presumed to be private with respect to the

payor.

We find instant claim 29 to be not anticipated by the reference, for substantially

the same reasons as claim 7, due to its requirements relating to a central network

station and a central database.

The remaining independent claim (claim 14) is broader than claims 7 and 29 in

some aspects. However, claim 14 does require at least a central network station that

generates and stores remittance information, with the remittance information capable of

being accessed via the central station by network stations of users different from the

users who transmit instructions to the central station to make payment of bills. In view

of our reading of the reference applied against the claim, we cannot sustain the

rejection for anticipation.

We thus cannot sustain the rejection against any of the claims under 35 U.S.C.

§ 102 as being anticipated by Chang. Nor can we sustain the alternative rejection of

the claims under 35 U.S.C. § 103 as being unpatentable over Chang. The statement of

the rejection (Final Rejection at 5-6) fails to, at least, identify the differences between

the subject matter to be patented and the applied prior art and amounts to, at best, a

general allegation of obviousness.

CONCLUSION

The rejection of claims 7, 8, 12-14, 17, 22, 23, 26, 27, and 29-32 under 35

U.S.C. § 102 or 103 over Chang is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge   )
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HOWARD B. BLANKENSHIP   ) BOARD OF PATENT
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)   AND
) INTERFERENCES
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ROBERT E. NAPPI   )
Administrative Patent Judge   )

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